

REMARKS

The Examiner's action and the grounds for rejection set forth therein have been carefully considered and the application has been amended accordingly. Claim 1 has been canceled and claim 2 has been rewritten in independent form. Claims 5, 6 and 8-10 have been amended to reflect their dependency from now independent claim 2. In addition, claims 1 (now rewritten as part of claim 2), 6 and 11 have been amended to remove the indefinite language "such as", "and the like" and "and/or." Moreover, claim 1 (now rewritten as part of claim 2) has been amended to overcome the rejection under 35 USC 112, second paragraph based on insufficient antecedent basis. It is respectfully urged that in its amended form, claim 2 is now in full compliance with the requirements of 35 USC 112, second paragraph. Accordingly, this ground of rejection should be reconsidered and withdrawn.

The Examiner objects to the drawings on the ground that they do not show each and every feature of claim 9. In this connection, claim 9 has been amended to recite that "the body part to be digitized is a body part for which a custom fit compression textile is to be made." Thus, the reference to a custom fit compression textile serves only to identify which body part is to be digitized. 37 CFR 1.83(a) requires only that the drawings show every feature of the invention specified in the claims. The custom fit compression textile is not a feature of the invention nor is it a structural detail that is of sufficient importance for a proper understanding of the disclosed invention. According to claim 9, where a body part to be digitized is one for which, in the future, a custom fit compression textile is to be made, then the body part is digitized together with the measurement aid. The feature of the invention is digitizing the body part and the measurement aid, not in identifying the body part as one for which a custom fit compression textile is to be made. Accordingly, the requirement to illustrate the custom fit compression textile should be reconsidered and withdrawn.

Claims 1-10 stand rejected under 35 USC 101 because the claimed invention is allegedly directed to non-statutory subject matter. This ground of rejection is respectfully traversed for the reasons set forth hereinafter. The Examiner asserts that the claims are directed to a judicial exception pursuant to the Interim Guidelines on Patent Eligible Subject Matter, stating that the claims must have either physical transformation and/or a useful, concrete and tangible result. According to the Examiner, inasmuch as the claims do not recite a physical transformation, the recited subject matter must be useful, concrete and tangible. The Examiner concedes that the claimed subject matter is useful and concrete, but asserts that there does not appear to be a tangible result claimed. Specifically, the Examiner

objects that for the results to be tangible, it would need to output to a user, be displayed to a user, stored for later use, or used in any tangible manner and that the steps recited in claim 1 (now claim 2) are insufficient to constitute a tangible result since the outcome of these steps does not transform a particular article. Inasmuch as the "useful, concrete and tangible" test is effectively dead following the Supreme Court's decision in *Bilski v. Kappos*, the Examiner's rationale is no longer the law.

Indeed, the Patent and Trademark Office has issued a post-*Bilski* notice to examiners instructing the use of the machine-or-transformation test for determining whether the claimed invention is a process under section 101. If a claimed method meets the machine-or-transformation test, the method is likely patent eligible under section 101 unless there is a clear indication that the method is directed to an abstract idea.

The present invention is directed to a method for optically detecting the spatial shape of bodies and body parts having partly non-visible regions. The steps of the process include providing a 3D digitizer, positively mounting at least one shape-retaining measurement aid to the non-visible body parts in such a way that the measurement aid protrudes into a measurement space visible for the 3D digitizer. The portion of the measurement aid which is so visible is provided with marks to be evaluated by the 3D digitizer, the marks being located in a known spatial position with respect to the remaining portions of the measurement aid. The measurement aid is made of a rigid material which is fixed at the non-visible body region such that the spatial position of this non-visible region can be calculated from the 3D digitization of the marked portion of the measurement aid. The method includes determining the spatial position of the marks together with the spatial shape of the visible body regions, determining geometrical information of the non-visible body regions from the measured spatial position of the visible portion of the measurement aid, using this geometrical information to supplement a description of the spatial shape of the body or body part which was incompletely digitized because of the non-visible regions and determining from the spatial position of the measurement aid and the spatial position of the visible body parts the 3D shape of the body or body parts. One very important use of the information produced by this method is in the production of products fitted to the human body, such as clothing, footwear, orthopaedic and medicinal aids, and the like. Prior art techniques using optical 3D scanners were limited to what they could see in order to form a 3D model. However, heretofore, non-visible regions were typically omitted because these scanners provided no information about them. In accordance with the present invention, the 3D shape of non-

visible regions can be determined using a measuring aid to provide geometric information about the non-visible region. This is particularly important, for example, in the production of above-knee prostheses wherein the shaft to be fitted encloses the entire thigh, particularly in the vicinity of the ramus. Another application is in the determination of the spatial shape of body parts for the dimensionally accurate manufacture of compression stockings for obese patients.

The purpose of the machine-or-transformation test is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an abstract idea or concept, or is simply a starting point for future investigation or research. The applicant is in the best position to explain why an invention is believed useful in a manner which enables one ordinarily skilled in the art to understand why the applicant believes the claimed invention is useful. Clearly, the foregoing explanation of the usefulness of the present invention, particularly when taken together with the specification, makes clear to one skilled in the art why the present invention is useful. Clearly, also, the present invention, as a method which involves the use of multiple "machines," e.g., measurement aids, 3D digitizers and computers, clearly meets the machine-or-transformation test and, equally clearly, is not an abstract idea. Here the real world result is knowledge of the three-dimensional shape of body parts having non-visible regions. Thus, applicant's invention is a practical method of producing a beneficial result, namely an accurate knowledge of the three-dimensional shape of non-visible regions of body parts to permit the production of custom fitted items.

Numerous patents have been granted for determining the 3D shape of body parts, all of which have been determined to be patent eligible methods. See, e.g., U.S. Patent No. 5,911,126, U.S. Patent No. 7,095,886, U.S. Patent No. 7,209,586, U.S. Patent No. 7,298,889, U.S. Patent No. 7,298,890, U.S. Patent No. 7,446,884 and U.S. Patent No. 7,489,813. In view of the foregoing, it should be appreciated that the claims of the present application meet all of the statutory criteria of 35 USC 101 and conform to the recent post-*Bilski* notice sent to all examiners. Accordingly, the rejection of claims under 35 USC 101 should be reconsidered and withdrawn.

Applicant gratefully acknowledges the Examiner's statement that claims 2-5 would be allowable if rewritten in independent form. Applicant has rewritten claim 2 in independent form. Claims 3-10 are also allowable because they depend, directly or

indirectly, from allowable claim 2. In addition, applicant gratefully acknowledges the allowance of claims 11 and 12. Accordingly, no discussion of the cited prior art is necessary.

In view of the foregoing, an early Notice of Allowance directed to claims 2-12 is respectfully requested. Should the Examiner have any formal objections to any of the remaining claims, it is requested that he telephone the undersigned to expedite the resolution of that objection and hasten the close of prosecution.

Respectfully submitted,



Stuart J. Friedman
Registration No. 24,312

Law Offices of Stuart J. Friedman P.C.
28930 Ridge Road
Mt. Airy, MD 21771
Telephone: (301) 829-1003
Facsimile: (301) 829-4107